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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,869	02/08/2002	Steve Phillips	PIP-105-PHIL	6496
31518 7590 02/27/2007 NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			EXAMINER CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3694	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/27/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/067,869	Applicant(s) PHILLIPS ET AL.	
	Examiner Mary Cheung	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 08 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/8/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. This action is in response to the application filed on February 8, 2002. Claims 1-14 are pending.

Information Disclosure Statement

2. The information disclosure statement filed February 8, 2002 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered. The list of PTO-1449 is missing from the file. It is requested to resubmit the list of the IDS.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-6 and 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 12 recite the limitation "said product purchase history". There is insufficient antecedent basis for this limitation in the claim.

Claims 6 and 13 are rejected for incorporating the errors of their respective base claims by dependency.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-5, 8 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker et al., US 5,945,653.

As to claim 1, Walker teaches a computer implement method comprising the steps of:

- a) Storing a CID on a card (Fig. 3);
- b) Activating an account associated with said card (column 4 lines 57-60);
- c) Providing said account with an initial credit (Fig. 3);
- d) Crediting at least one purchase transaction associated with said CID (column 18 line 57 – column 19 line 56 and column 21 line 42 – column 22 line 14 and Figs. 5-7C, 9);
- e) Determining conditions for future credits associated with said CID (column 18 line 57 – column 19 line 56 and column 21 line 42 – column 22 line 14 and Figs. 5-7C, 9);

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f) Storing said conditions in an account associated with said CID (column 18 line 57 – column 19 line 56 and column 21 line 42 – column 22 line 14 and Figs. 5-7C, 9);

g) Crediting charges in a subsequent purchase transaction associated with said CID when said conditions are satisfied (column 18 line 57 – column 19 line 56 and column 21 line 42 – column 22 line 14 and Figs. 5-7C, 9).

As to claim 4, Walker teaches storing product purchase history for products purchased in associates with said CID (column 2 lines 40-53).

As to claim 5, Walker teaches said conditions depend upon said product purchase history stored in association with said CID meeting criteria (Fig. 9).

Claims 8 and 11-12 are parallel with claims 1 and 4-5, thus they are rejected on the same basis.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 7, 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., US 5,945,653 in view of Horgan, US 2002/0022966 A1.

As to claims 2 and 9, Walker does not specifically teach the card is sold to a consumer as a gift card defining a right to specified credit in specified store. However, Horgan teaches this matter (§ 19). It would have been obvious to one of ordinary skill in

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the art at the time the invention was made to allow the card in Walker's teaching to be a gift card as taught by Horgan for better promoting the sales of the products or services provided by the specified stores.

As to claims 7 and 14, Walker does not specifically teach a third party selling said card to a consumer at a face value price, said card providing a right to credit in an amount of said face value in a retailer store, and said retailer store charging said third party less than said face value for said card. However, Horgan teaches this matter (§ 19, 25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a third party selling said card to a consumer at a face value price, said card providing a right to credit in an amount of said face value in a retailer store, and said retailer store charging said third party less than said face value for said card as taught by Horgan for better promoting the sales of the products or services provided by the retailer stores.

9. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., US 5,945,653 in view of Risafi et al., US 6,473,500 B1.

As to claims 3 and 10, Walker does not specifically teach the card is one of a plurality of store cards batch activated and postal mailed to consumer's postal addresses. However, Risafi teaches this matter (column 2 lines 9-12 and column 10 lines 12-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the card in Walker's teaching to be one of a plurality of store cards batch activated and postal mailed to consumer's postal addresses as taught

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by Risafi for better promoting the sales of the products or services provided by the stores.

10. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., US 5,945,653 in view of Packes, Jr. et al., US 7,006,983 B1.

As to claims 6 and 13, Walker does not specifically teach said criteria are transmitted from a manufacturer to a central computer storing product purchase history data associated with CIDs from a plurality of retail stores and retail store companies. However, this matter is taught by Packes as manufacturer servers and plurality of retail terminals are connected to a central computer, and the central computer stores incentive information received from the manufacturers including meeting criteria of the incentives, and the central computer also stores consumer's purchase history information associated with CID received from the retailers (Figs. 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the criteria in Walker's teaching to be transmitted from a manufacturer to a central computer storing product purchase history data associated with CIDs from a plurality of retail stores and retail store companies as taught by Packes for centralizing transaction information of the purchases.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (571)-272-6705. The examiner can normally be reached on Monday – Thursday from 10:00 AM to

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7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (571) 272-6712.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

Mary Cheung
February 15, 2007



MARY D. CHEUNG
PRIMARY EXAMINER